

REMARKS

In this response, no claims were canceled, no claims were added, and no claims were amended. As a result, claims 1-24 are now pending in this application.

Election/Restriction Response

The Restriction Requirement mailed on July 28, 2006 required an election to one of the following:

- | | |
|----------|---------------|
| Group I | claims 1-11. |
| Group II | claims 12-24. |

Applicant provisionally elects claims 1-11, that are indicated by the Restriction Requirement on page 2 as belonging in Group I, with traverse.

As stated below, the Restriction Requirement fails to establish a *prima facie* case for the restriction by failing to meet the requirements for forming a Restriction Requirement.

As further stated below, Applicant does not agree with the classifications and sub-classifications imposed by the Restriction Requirement with respect to the subject matter included in claims 1-24, and believes that the attempted categorization of claim 1-24 as described in Restriction Requirement improperly limits the subject matter included in each of claims 1-24, and therefore is an improper basis for the restriction of claim 1-24.

The restriction requirement is traversed on the basis that it fails to meet the two criteria for a proper requirement for restriction between patentably distinct inventions. M.P.E.P. § 803 states that the two criteria for restriction between patentably distinct inventions are:

- (A) The inventions must be independent or distinct as claimed; and
- (B) There must be a serious burden on the examiner if restriction is required.

There must be a serious burden on the examiner if restriction is required. There is clearly a lack of "serious burden" in the examination of claims 1-24 as currently pending in the application, in view of the prosecution history of claims 1-24 in this application and based on the guidelines as discussed below for examination of claims in a pending application.

MPEP Requirements for Prior Art Searching

Recommendation for One Search

MPEP § 904 explains how an examiner should conduct a search:

“The first search should cover the invention as described and claimed, including the inventive concepts toward which the claims appear to be directed. It should not be extended merely to add immaterial variants.”¹

MPEP § 904.03 provides further directions for conducting the search:

“It is a prerequisite to a speedy and just determination of the issues involved in the examination of an application that a careful and comprehensive search, commensurate with the limitations appearing in the most detailed claims in the case, be made in preparing the first action on the merits so that the second action on the merits can be made final or the application allowed with no further searching other than to update the original search.”²

The Applicant respectfully points out that the independent claims 1, 12, and 22 have contained the elements outlined below since at least August 23, 2001 when these claims were filed under 37 U.S.C. § 1.53(b), and that the elements outlined below have been searched four times.

- Claim 1 has included the elements:

a command interpreter engine to detect keywords in speech input;
a search and analysis engine to search a network for contents based on the keywords; and
a transformation engine to convert a data format used in the contents retrieved from the network into a format supported by a client device.

- Claims 12 and 22 have included the elements:

extracting a feature from user input;
translating the feature into a request;
retrieving contents from a network based on the request; and
adapting the contents to a client.

¹ See MPEP § 904 “How to Search”.

² See MPEP § 904.03 “Conducting the Search.”

Since the filing of the application in August 2001 as stated above, four Office Actions were issued in this application on the following dates:

- Non-final Office Action mailed July 21, 2004.
- Final Office Action mailed January 25, 2005.
- Non-final Office Action mailed June 21, 2005.
- Final Office Action mailed December 2, 2005.

Prior to issuing each of the four Office Actions listed above, Applicant presumes that the Patent Office's search was updated. If each of the four prior art searches met the requirements of MPEP § 904.03 (i.e., the searches were "careful and comprehensive search, commensurate with the limitations appearing in the most detailed claims in the case"), then the Applicant respectfully submits that the four searches have covered the currently pending claims up to and including the time of the last Final Office Action mailed December 2, 2005. Thus, any additional "serious burden" placed on the Examiner must therefore be the result of the amendments made in the claims in the response to the Final Office Action of December 2, 2005.

However, in response to the Final Office Action mailed December 2, 2005 the Applicant did not amend independent claim 1, and merely amending both claims 12 and 22 as follows:

receiving a description of a client device's capabilities and a user input including data from [[a]] the client device.

These amendments to claims 12 and 22 where the only amendments to the claims made by the Applicant in response to the Final Office Action of December 2, 2005. In reply to these amendments, an Advisory Action was mailed from the Patent Office on February 23, 2006 that stated, "The scope of the invention has been changed with new amended claims "receiving a description of a client device's capabilities...which would require further consideration and or search." Applicant responded to the Advisory Action by filing a Request for Continued Examination (RCE) along with the associated fee to cover the cost of the continued examination. This fee would presumably cover any additional search required as a result of the amendments to claims 12 and 22.

The reply to this submission of an RCE and the requisite fee was the above mentioned Restrictions Requirement. However, MPEP § 803 states: "If a search and examination of an

entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." Applicant believes that a search of the amendments to claims 12 and 22 of "receiving a description of a client device's capabilities," especially in light of Applicant's filing of an RCE and payment of the fee to cover the cost of any additional search, fails to present a "serious burden" on the Examiner.

Thus, Applicant submits that there is no serious burden on the Examiner that would merit the present restriction. Applicant respectfully requests that the Examiner withdraw the restriction requirement and proceed with the examination of the application on the merits.

The Inventions Must Be Independent Or Distinct As Claimed. The Restriction Requirements fails to show how claims 1-11 and claims 12-24 are independent or distinct as claimed, and thus again fails to meet the requirements for imposing a restriction on claims 1-24.

The Restriction Requirements fails to provide any statements related to how claims 1-11 and claims 12-24 are "independent." Instead, the Restriction Requirement is based on MPEP § 806.05(d). However, it is respectfully submitted that the requirements for making a restriction under MPEP § 806.05(d) have not been met. For example, the Restriction Requirement fails to show how claims included in Group I and Group II may be separately usable, and as a result, thus fails to show how the claims in Group I and Group II are distinct from each other. The M.P.E.P. states:

The examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination.
... The burden is on the examiner to provide an example. (*MPEP § 806.5(d)*).

Applicant respectfully submits that no such example is provided in the Restriction Requirement, and therefore the requirements for making a restriction under MPEP § 806.05(d) have not been shown met. The Restriction Requirement fails to provide, by way of example, that one of the subcombinations (Applicant does not admit that claim 1-11 and 12-24 are subcombinations of one another) has utility other than in the disclosed combination, as required by MPEP § 806.05(d). Thus, while Applicant does not agree that claims 1-11 and 12-24 represent two or more claimed subcombinations in a disclosed combination, the Restriction

Requirement has clearly failed to meet the requirements of MPEP § 806.05(d), upon which the basis for the Restriction Requirement was made. Thus, the Restriction Requirement has failed to establish a *prima facie* case for the restriction of claims 1-24.

Still further, Applicant believes that the Restriction Requirement is improper because the Restriction Requirement attempts to categorize claim 1-24 into classes and subclasses which improperly categorize and improperly limit the subject matter included in each of claims 1-24.

For example, the Restriction Requirement on page 2 states,

Group I, claims 1-11, drawn to **audio message storage and retrieval**, classified in class 379, subclass 67.1.
(Emphasis added).

Applicant disagrees that claim 1-11 are necessarily drawn to or limited to "audio message storage and retrieval," as suggested in the Restriction Requirement. Claim 1, from which claim 2-11 depend, states,

A gateway, comprising:
 a service sniffer to direct inputs to a plurality of portals
based on the type of data received from a client device;
 a command interpreter engine coupled to one or more of the plurality of portals to detect keywords in speech when the data received includes a compressed speech input;
 a search and analysis engine to search a network for contents based on the keywords; and
 a transformation engine to convert a data format used in the contents retrieved from the network into a format supported by the client device. (Emphasis added)

Thus, claim 1 includes, "a service sniffer to direct inputs to a plurality of portals **based on the type of data received** from a client device." However, there is no basis for the type of data received in claim 1 to be limited to any particular type of data, especially audio data. And while claim 1 states, "a command interpreter engine coupled to one or more of the plurality of portals to detect keywords in speech *when* the data received includes a compressed speech input," the subject matter, including the "data received from a client device," and "a data format used in the contents retrieved from the network," as also included in claim 1, is not necessarily limited to "audio message storage and retrieval" as suggested in the Restriction Requirement.

The notion that claim 1 is limited to being "drawn to **audio message** storage and

retrieval" (emphasis added) is further contradicted by the subject matter as included for example in claim 2, which states,

The gateway of claim 1, wherein the transformation engine is to convert **an image from one format into another format.**
(Emphasis added).

The fact that claim 2, which depends from claim 1, specifically refers to a transformation engine to convert *an image* from one format into another format contradicts the statements on page 2 of the Restriction Requirement that claims 1-11 are "drawn to audio message storage and retrieval."

In a further example of how the Restriction Requirement improperly classifies claims 1-24, claims 12 and 24 recite,

receiving a description of a client device's capabilities and a user input including data from the client device;
directing the user input to one or more of a plurality of portals based on the type of data received in the user input;
extracting a feature from the data included in the user input;
translating the feature into a request;
retrieving contents from a network based on the request.

Claim 12 further includes, "adapting the contents to a client," and claim 24 further includes, "adapting the contents for transmission to a telephone." Thus, claims 12 and 24 include, "receiving a description of a client device's capabilities and a user input including data from the client device," and "adapting the contents to a client." and "adapting the contents for transmission to a telephone." However, there is no basis for the description of a client device's capabilities and a user input including data from the client device, or the content to a client, as included for example in claim 1, to be limited to "a visual presentation of a signal," as suggested in the Restriction Requirement.

The notion that claim 12 is limited as being "drawn to **a visual presentation** of a signal" (emphasis added) is further contradicted by the subject matter as included for example in claim 13, which depends from claim 12 and which states,

The method of claim 12, wherein the adapting further comprises converting text to audio speech.

And further, the notion that claim 24 is limited as being "drawn to **a visual presentation of a signal**" (emphasis added) is also contradicted by the subject matter as included for example in claim 24, which depends from claim 22 and which states,

The program product of claim 22, wherein the adapting further comprises:
translating text in the contents into audio speech.

The fact that claim 13, which depends from claim 12, specifically refers to converting text to audio speech, and the fact that claim 24, which depends from claim 22, specifically refers to translating text in the contents into audio speech, provides clear contradictions to the statements on page 2 of the Restriction Requirement that claims 12-24 are limited as being "drawn to visual presentation of a signal."

Because the classifications and sub-classifications used as a basis for the restriction of claims 1-24 improperly categorizes the subject matter as included in each of claims 1-24, and because the statements made in the Restriction Requirement in support of these categorizations are contradicted by the subject matter as recited in claim 1-24, the Restriction Requirement of claim 1-24 is improper. Without a proper showing of the classes and sub-classes of claims 1-24, the Restriction Requirement fails to show that the claimed invention of claims 1-24 are two or more distinct inventions.³ Without such a showing, "restriction is never proper."⁴

For at least the reasons stated above, the Restriction Requirement has failed to establish a *prima facie* case for restricting claims 1-24, and the examination of claims 1-24 does not present an undue burden on the Examiner. Applicant respectfully requests that the Restriction Requirement be withdrawal, and that examination of the application proceed, including reconsideration and allowance of claims 1-24.

³ See Manual of Patent Examining Procedure, Original Eighth Edition, August 2000, Latest Revision, October 2005, 806.05 Related Inventions [R-3].

⁴ *Id.*

CONCLUSION

The Examiner is invited to telephone Applicant's attorney at (612) 371-2132 to facilitate the prosecution of this application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 28th day of August 2006.

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